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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,097	12/27/2000	Hideki Toshikage	7254/63305	6249

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,097

Applicant(s)

TOSHIKAGE ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 1-39 are pending. Claims 1 and 18 have been amended.

Response to Arguments

2. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claims 2-34 are objected to because of the following informalities:
 - a) In line 4 of claim 2, the phrase "said image" should be "said digital image";
 - b) In line 8 of claim 18, the phrase "said image" should be "said digital image";
 - c) In line 4 of claim 19, the phrase "said image" should be "said digital image";
 - d) In claims 2-17 and 19-34, all the "said image data" should be "said digital image".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Garfinkle et al., U. S. Patent 6,017,187.

As to claim 1, Ginter teaches an image commercial transactions system comprising (Fig. 1):

- a) A reception dealer having a image scanner for converting a document into a digital image and for accepting a sale of said digital image with a handling condition associated with said digital image and for selling said digital image with said handling condition in a digital data format (column 53 lines 39-60 and column 54 lines 26-56 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching*);
- b) A charge accounting dealer for effecting an electronic charging accounting transaction for the purchase of said digital image with said

handling condition in said digital data format (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

Ginter teaches the digital image being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanner for converting a document into digital image as discussed above. Ginter does not explicitly teach the image scanner is a photographic image scanner for converting a picture on a photographic film into a digital image. Garfinkle teaches an image scanner that converts a picture on a photographic film into a digital image (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow the image scanner in Ginter's teaching to be a photographic image scanner for converting a picture on a photographic film into a digital image because it would allow the picture related data to be better captured, efficiently stored, and later to be better distributed.

As to claim 2, Ginter teaches said reception dealer generate predetermined additional information for said image, and distributes said generated additional information in a digital format, along with said handling condition data containing information of a selling price of said image data (column 54 lines 26-56).

As to claim 3, Ginter teaches said reception dealer distributes said additional information data containing information as to a payment condition for purchasing said image data, information as to a recorder's name of said image data, information as to a recorder's history of said image data, information as to a

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type of data format of said image data, information as to advertisement data synthesized with said image data, text information data synthesized with said image data, and processing information data synthesized with said image data (column 24 lines 24-53 and column 54 lines 26-56 and column 317 lines 22-42 and column 320 lines 2-20).

As to claim 4, Ginter teaches said reception dealer distributes said image data subjected to a scrambling process (column 59 lines 48-54).

As to claim 5, Ginter teaches said reception dealer distributes said additional information data containing information as to whether said image data is subjected to said scrambling process (column 59 lines 48-67).

As to claim 6, Ginter teaches said reception dealer distributes said additional information data containing predetermined key data useful in said scrambling process for said image data (column 59 lines 48-67).

As to claim 7, Ginter teaches said reception dealer distributes said image data subjected to a masking process (column 150 lines 35-43).

As to claim 8, Ginter teaches said reception dealer distributes said additional information data containing information as to whether said image data is subjected to said masking process (column 150 lines 35-43).

As to claim 9, Ginter teaches a delivery dealer for receiving and delivering said image with said handling condition data to a purchaser (column 54 line 18 – column 55 line 31).

As to claim 10, Ginter teaches said delivery dealer synthesizes said advertisement data contained in said additional information data and said image

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for delivery to said purchaser (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 11, Ginter teaches said delivery dealer synthesizes said text information data contained in said additional information data and said image data for delivery to said purchaser (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 12, Ginter teaches said delivery dealer synthesizes said processing information data contained in said additional information data and said image data for delivery to said purchaser (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 13, Ginter teaches a delivery dealer for receiving and delivering said image data with said handling condition to a purchaser, wherein said delivery dealer performs a descrambling process of said image data based on said key data contained in said additional information data for delivery to said purchaser (column 54 line 18 – column 55 line 31 and column 59 lines 42-67).

As to claims 14-16 and 30-32, Ginter teaches said delivery dealer synthesizes said advertisement data, said text information data, or processing information data contained in said additional information data and said image data for delivery to said purchaser as discussed above (column 317 lines 22-42 and column 320 lines 2-20).

Ginter does not specifically teach the reception dealer changes said selling price of said image data depending on whether said advertisement data, said text information data, or said processing information is synthesized with said

image data. However, Ginter teaches reception dealer gives a discounted price for a certain quantity of certain data, and supports advertising for the purpose of lower price to the users (column 22 lines 33-52 and column 30 lines 40-48). It would have been obvious to one of ordinary skill in the art to allow the reception dealer of Ginter to change the selling price of the image data based on whether certain information (i.e. advertisement) is synthesized with the image data because users could receive a discounted price of the purchase by reviewing the synthesized data, and the data provider could also be benefit by promoting its products through the synthesized data.

As to claims 17 and 33-34, Ginter teaches reception dealer gives a discounted price for a certain quantity of certain data, and supports advertising for the purpose of lower price to the users (column 22 lines 33-52 and column 30 lines 40-48). Ginter does not specifically teach the reception dealer changes said selling price of said image data depending on whether said image data is subjected to said scrambling process or said masking process. However, Ginter teaches charging fees based on the services that are provided to the user, such as fees for decrypting data (column 42 line 35 – column 43 line 20). It would have been obvious to one of ordinary skill in the art to allow the reception dealer of Ginter to change the selling price the image data based whether the scrambling process or the masking process are performed so that the image data provider can be better compensated for the services that provided to the users.

As to claim 18, Ginter teaches an image commercial transactions method comprising (Fig. 1):

- a) An image scanning step for converting a document into a digital image (column 299 lines 36-42);
- b) A reception step of enabling a reception dealer to accept a sale of said digital image with a handling condition associated with to said image (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and column 299 lines 36-42 and Figs. 1, 15A; *specifically, "a handling condition" corresponding to the "rules and controls" in Ginter's teaching*);
- c) A sale step of enabling said reception dealer to sell said digital image with said handling condition in a digital data format (column 53 lines 9-60 and column 54 line 26 – column 55 line 31 and Figs. 1, 15A);
- d) A charge accounting step of enabling a charge accounting dealer to effect an electronic charge accounting transaction for a purchase of said digital image with said handling condition in said digital data format (column 55 lines 44-60 and column 58 lines 3-63 and Figs. 1A, 3-4).

Ginter teaches the digital image being transmitted including pictures (column 59 lines 28-30 and column 283 lines 5-12), Ginter also teaches an image scanning step for converting a document into digital image as discussed above. Ginter does not explicitly teach the image scanning step is for converting a picture on a photographic film into a digital image. Garfinkle teaches an image scanning step for converting a picture on a photographic film into a digital image (column 2 lines 53-61 and column 3 lines 34-51 and Figs. 1, 3). It would have been obvious to one of ordinary skill in the art at the time the inventions was made to allow the image scanning step in Ginter's teaching include the feature of

converting a picture on a photographic film into a digital image because it would allow the picture related data to be better captured, efficiently stored, and later to be better distributed.

Claims 19-29 are rejected for the similar reasons as claims 2-13.

As to claims 35-39, Ginter teaches a publication step that displays transaction history (column 24 lines 24-53 and column 258 line 30 – column 259 line 12 and Fig. 72D). Ginter discloses the claimed invention, as discussed above, except for the step of displaying collectively image to be sold, or displaying the image to be sold together with a payment condition for purchasing the image or with a recorder's name of image or with a recorder's history. It would have been an obvious matter of design choice to modify the teachings of Ginter to provide the step of displaying such contents. Since the applicant has not disclosed that displaying collectively image to be sold, or displaying the image to be sold together with a payment condition for purchasing the image or with a recorder's name of image or with a recorder's history solves any stated problem in a new or unexpected way or is for any particular purpose which is unobvious to one of ordinary skill and it appears that the claimed feature does not distinguish the invention over similar features in the prior art since, the teachings of Ginter will perform the invention as claimed by the applicant with any means, method, or product to display such contents.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

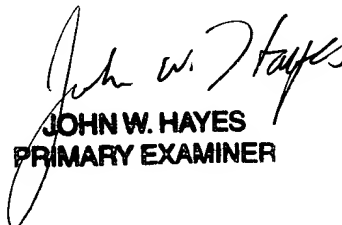
The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
December 22, 2003


JOHN W. HAYES
PRIMARY EXAMINER